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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|---------------------|
| 10/614,680 | 07/03/2003 | Markus Weber | STERN16.001AUS | 7379 |
| 20995 | 7590 | 08/23/2006 | | EXAMINER |
| KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614 | | | | MANOHARAN, VIRGINIA |
| | | | ART UNIT | PAPER NUMBER |
| | | | | 1764 |

DATE MAILED: 08/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|--------------------------------|------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 10/614,680 | WEBER ET AL. |
| | Examiner Virginia Manoharan | Art Unit 1764 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 05 June 2006.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-26 is/are pending in the application.
 - 4a) Of the above claim(s) 24-26 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-13 is/are rejected.
- 7) Claim(s) 14-23 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

| | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 -13 are rejected under 35 U.S.C. 103(a) as being unpatentable over GB 1108584 and Ligorati et al (4,339,605).

The above references are applied for the same combined reasons as set forth at paragraph bridging pages 3 and 4 of the previous Office Action.

Claims 14-23 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Applicants' arguments filed June 5, 2006 have been fully considered but they are not persuasive.

Applicants' argument that the “.. starting material for the acidic treatment according the GB '584 reference is totally different from the starting material as defined by the present Claim 1...” is of no patentable moment. Just because the starting material is new and unobvious does not impart patentability to the process of GB '584. See *In re Durden et al* 226 USPQ 359. Although GB '584 is directed principally to the phenol fraction recovered from a reaction mixture resulting from the acid cleavage of the

hydroperoxide, however, GB '584 process material is not limited. Note e.g., page 1, lines 59-73. Furthermore, the claims are not limited to the argued “.. direct separation of mesityl oxide from the phenol-containing fraction..” commensurate in scope with the claimed invention. The argued additional process of GB '584, i.e., the mesityl oxide is converted into low boilers, although not required by the claims, are not excluded therefrom with the “comprising” recitation which is all-inclusive. Moreover and contrary to applicants' assertion, GB '584 disclosure at page 1, lines 85-88 to page 2, lines 1-7; and page 3, lines 115-117 would at least be suggestive of the argued “possibility to concentrate the mesityl oxide containing fraction” as the lower boiling compound would necessarily contain mesityl oxide (no process would effect 100% conversion) that is flashed to separate from the phenol fraction. Applicants' further argument that “.. the purpose of the presently claimed invention is convert mesityl oxide present in the waste stream from acetone purification into a valuable product, i.e. acetone, in order to minimize the loss of the valuable material. The purpose of the method described in G8'584 is to reduce the impurities in the crude phenol because mesityl oxide is very difficult to separate from phenol..” is of no patentable significant. It is irrelevant that the suggested purpose in prior art is different from applicants' purpose where the prior art fairly teaches doing the same thing. Clearly, GB '584 is similar to what applicants contemplate doing. That is, interalia separating out mesityl oxide from a mixture containing same.

Absolute predictability is not a prerequisite for obviousness rejection. All that is required to show obviousness is that the applicant make his claimed invention merely by applying knowledge clearly present in the prior art. Section 103 requires us to presume full knowledge by the inventor of the prior art in the field of his endeavor. See In re Winslow, 53 CCPA 1574, 1578, 365 F.2d 1017, 1020, 151

USPQ 48, 50-51 (1966). No commercial success is claimed, nor is any other factor indicating nonobviousness shown to exist.

THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

This application contains claims 24-26 drawn to a nonelected invention. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Virginia Manoharan whose telephone number is 571-272-1450.

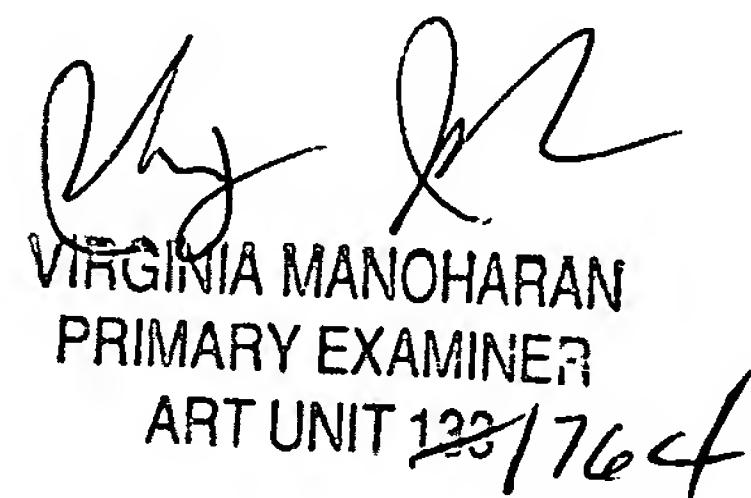
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola, can be reached on 571-272-1444. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



VIRGINIA MANOHARAN
PRIMARY EXAMINER
ART UNIT 123/1764